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FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON DC 20007

63/15/2006 SBASHEIR 00000002 190741 10533523
#1 PL:1463 200.00 DA

In re Application of HAFALIA et al.
Application No.: 10/533,523
PCT No.: PCT/US03/34809
Int. Filing: 30 October 2003
Priority Date: 1 November 2002
Attorney Docket No.: 039386-2257
For: KINASES AND PHOSPHATASES

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: DECISION ON PETITION
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: UNDER 37 CFR 1.47(a)
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This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 15 May 2006, in response to a Notification of Missing Requirements. Applicant requests a one month extension of time, which is granted.

BACKGROUND

On 02 May 2005, within thirty months of the priority date (01 May 2005 was a Sunday), applicant filed a transmittal letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 14 February 2006, a Notification of Missing Requirements was mailed to applicant indicating, *inter alia*, that an oath or declaration, in compliance with 37 CFR 1.497(a) & (b), and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 15 May 2006, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signatures of 9 inventors: April J.A. Hafalia, Jagi Murage, Anita Swarnakar, Narinder K. Chawla-Walia, Jayalaxmi Ramkumar, Kimberly Gietzen, Kristen D. Favero, Ernestine A. Lee and Joseph P. Marquis. Applicant alleges that these inventors refuse or are unavailable to sign the application. The petition included the requisite petition fee charged to applicant's deposit account and declarations signed by the joint inventors on their behalf and on behalf of nonsigning joint inventors. A statement of facts under 37 CFR 1.47(a) with regard to each nonsigning inventor was also submitted.

DISCUSSION

A petition under 37 CFR § 1.47(a) must be accompanied by (1) the fee under 37 CFR § 1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) is satisfied with the payment of the \$200 petition fee. Item (3) is satisfied because the last known address for each non-signing inventors was provided. With regard to Item (4), declarations executed by the available joint inventors on their behalf and on behalf of the non-signing inventors were submitted. Item (4) is satisfied.

However, for the reasons set forth below, Item (2) is not satisfied. Counsel's statement reflects the efforts she made or that were made by her legal assistant, on her behalf to support the petition under 37 CFR 1.47(a).

MPEP § 409.03(d) states that where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a *statement of facts by the person who presented the inventor with the application papers* and/or to whom the refusal was made. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

With regard to contacting each of the above named nonsigning inventor, Attorney of Record Michele Simkin (Counsel) states that she forwarded a copy of the declaration and the above identified application. (A copy of her letter to each inventor was attached.) However, it is not clear that the application papers were presented to the inventor.

The facts with regard to inventors Hafalia, Swarnakar, Chawla, Ramkumar, Gietzen, Lee, and Marquis are similar. In each case, the application papers were allegedly delivered to the last known address of the respective inventors.¹ The Federal Express Track Shipment detail indicates that "package delivered to recipient address". There is no indication that the papers were signed for by or delivered to the inventor. This is not sufficient proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.

Follow-up telephone calls to each inventor's last known telephone number², with the exception of inventors Swarnakar Lee and Marquis, were unsuccessful. Upon contacting directory assistance, no phone listing in *California* was found for these respective inventors. Thus, Petitioner has not provided the evidence that a copy of the application papers including the declaration were *presented to and received by each inventor*. Such evidence is needed to prove that each inventor received the papers and refuses to sign.

With regard to inventors Murage and Favero, Counsel states that she forwarded a copy of the declaration and the above identified application, but Federal Express was unable to deliver them. In each case, according to Federal Express, the inventor moved and left no forwarding address. Counsel's legal assistant attempted to telephone these inventors, however, their respective phone numbers were disconnected. Upon contacting directory assistance, no phone

¹ The application papers were allegedly delivered to Ms. Lee by Federal Express on 1 February 2006, to Mr. Marquis on 22 March 2006 and to the remaining listed inventors delivery occurred on 31 January 2006.

² Follow-up telephone calls to Ms. Swarnakar. Ms. Lee and Mr. Marquis' respective telephone numbers were unanswered, messages were allegedly left by the legal assistant and were not returned. A first hand statement from Counsel's legal assistant was not provided and would be required to provide a first hand statement of facts *detailed the specific efforts made* to contact the inventors.

listing in *California* was found for each inventor. This is insufficient evidence to conclude that the non-signing inventors are unavailable.

Section 409.03(d) states, in pertinent part: where inability to find or reach a nonsigning inventor "*after diligent effort*" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is temporarily unavailable (on vacation or out of town) to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioner has not provided evidence of the diligent efforts made to locate the whereabouts of the nonsigning inventors. A returned mailing does not demonstrate the inventors' refusal to sign the application. Since the inventors are no longer available at their last known address, details regarding the diligent efforts to contact the nonsigning inventors using Internet searches, telephone, e-mail or contacting the last known employment or the joint inventors regarding their whereabouts should be provided in a statement by a person having first hand knowledge of such search. This statement should demonstrate the diligent efforts undertaken to show the nonsigning inventors' unavailability. Petitioner has not provided sufficient evidence to conclude that the nonsigning inventors refuse or are unavailable to sign the application and thus, item (2) has not been met.

Petitioner has not yet satisfied Item (2) above and thus, the requirements of 37 CFR 1.47(a) are not satisfied at this time. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

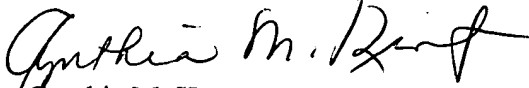
It is noted that it appears that inventor Narinder K. Chawla has changed her name to Narinder K. Chawla-Walia. Applicant has not provided a communication from the International Bureau (Form PCT/IB/306) indicating the Recording of a Change in the name of inventor Narinder K. Chawla to Narinder K. Chawla-Walia. Applicant must provide either such communication or file a petition under 37 CFR 1.182 to accept the change in the name of the inventor. As explained in MPEP 605.04(c), applicant must provide a signed affidavit, setting forth both names and the procedure whereby the change of name was effected, or a certified copy of the court order. Here, applicant should submit the statement of Narinder K. Chawla regarding her respective change of name.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT,
Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of
the letter marked to the attention of the Office of PCT Legal Administration.



Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (571) 272-3286
Fax: (571) 273-0459